

REMARKS

Claims 3, 4, 6-13 and 17-36 are pending in the present application. No claim amendments, claim cancellations or new claims are presented herein.

SPECIFICATION

Reconsideration and withdrawal of the objection to the specification is respectfully requested. The examiner has objected to the specification, pointing out that the *Brief Description of the Drawings* and the drawings as filed do not conform to one another.

Applicant has proposed amendments to the drawings that will conform the specification as filed and the drawings to one another. In accordance with MPEP §608.02, Applicant also has submitted herewith a separate Request for Drawing Change, along with copies of the amended drawings with changes indicated and substitute drawings. Upon approval by the Examiner of the amended drawings with changes indicated in red ink, new formal drawings will be submitted.

More specifically, Applicant proposes cancellation of Figures 1A-C, and 2-5; re-labeling of Figures 6A-C as Figures 1A-C, respectively, and substitution of the re-labeled figures for canceled Figures 1A-C; re-labeling of Figure 7 as Figure 2 and substitution of the re-labeled figure for canceled Figure 2; and substitution of Figures 3-7 as filed with the substitute drawings labeled Figures 3-7, respectively. The changes are proposed merely so that the specification as filed and the drawings conform to one another. No new matter has been added. In addition, the drawing changes conform to the specification and drawings as filed in previously filed co-pending application 08/483,535, to which the present application claims priority

In view of the above, it is therefore believed that the objection to the specification should be withdrawn.

CLAIMS

Rejection under 35 USC §101, Statutory Type Double Patenting

Reconsideration and withdrawal of the statutory double patenting rejection of claims 3,4, 6-13, 20, 22, 24, 29 and 30 in view of U.S. Patent No. 5,556,772, is respectfully requested.

U.S. Pat. No. 5,556,772 has no inventive entity or assignee in common with the present application. In view of the above, it is believed that the 35 USC §101, statutory-type double patenting rejection should be withdrawn.

Rejection under Non-statutory Obviousness-type Double Patenting Doctrine

Reconsideration and withdrawal of the non-statutory, obviousness-type double patenting rejection of claims 17-19, 21, 23, 25-28 and 31-36 in view of U.S. Patent No. 5,556,772 and U.S. Patent No. 6,410,277 B1 is respectfully requested.

As explained above, U.S. Pat. No. 5,556,772 has no inventive entity or assignee in common with the present application. Further, U.S. Patent No. 6,410,277 B1 standing alone does not teach or suggest the recitations of claims 17-19, 21, 23, 25-28 and 31-36 in the present application. In view of the above, it is believed that the non-statutory obviousness-type double patenting rejection should be withdrawn.

Rejection Under 35 USC 112

Claims 20 and 22-36 have been initially rejected under 35 USC 112, second paragraph, as being indefinite. Reconsideration and withdrawal of the rejection is respectfully requested.

The Examiner asserts that the use of the term "comprises" renders claims 20 and 22-36 indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. More specifically, the Examiner asserts that use of the term "comprises" renders the scope of the claims vague.

MPEP §706.03(d) and §2173.02 provide that a rejection under 35 USC 112, second paragraph, of claims for which the scope can be determined by one of ordinary skill in the art, is inappropriate. Definiteness is to be determined in light of, *inter alia*, the content of the application.

In the present case, the application discloses that the first DNA polymerase ("E1") includes one or more DNA polymerases that lack 3'-exonuclease activity, while the second DNA polymerase ("E2") includes one or more DNA polymerases that exhibit 3'-exonuclease activity. (See, e.g. page 20, line 28 - page 22, line 5). Therefore, use of the term "comprises" is both appropriate and definite, and Applicant respectfully submits that the scope of the claims is readily apparent. In view of the above, claims 20 and 22-36 are submitted as patentable and withdrawal of the rejection is respectfully requested.

CONCLUSION

As it is believed that claims in the present application are in condition for allowance, favorable action is respectfully solicited.

Should the Examiner have any questions, or would like to discuss any matters in connection with the present application, he is invited to contact the undersigned at (314) 259-5810.

In accordance with 37 C.F.R. 1.17(a)(1), Applicant submits herewith the fee of \$110.00 for an extension of one month to the time period set for response up to and including November 16, 2002. It is believed that no additional fee is due. However, please charge any fee deficiency or credit any overpayment under 37 C.F.R. 1.16 or 1.17 to Deposit Account No. 19-3140.

Respectfully submitted,

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